

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P3108											
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>July 18, 2006 (filed via EFS)</u> Signature <u>/Michele Zarinelli/</u> Typed or printed name <u>Michele Zarinelli</u>		Application Number 10/687,728	Filed 10/16/2003										
		First Named Inventor Kwen-Yih Hwang											
		Art Unit 2617	Examiner Brandon Miller										
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u>/Michael B. Johannesen/</u></td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Signature <u>Michael B. Johannesen</u></td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,557</u></td><td>Typed or printed name <u>(630) 430-1502</u></td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>Telephone number <u>July 18, 2006</u></td></tr><tr><td></td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.	<u>/Michael B. Johannesen/</u>	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature <u>Michael B. Johannesen</u>	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,557</u>	Typed or printed name <u>(630) 430-1502</u>	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number <u>July 18, 2006</u>		Date
<input type="checkbox"/> applicant/inventor.	<u>/Michael B. Johannesen/</u>												
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature <u>Michael B. Johannesen</u>												
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,557</u>	Typed or printed name <u>(630) 430-1502</u>												
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number <u>July 18, 2006</u>												
	Date												

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket Number (Optional)

P3108

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] **July 18, 2006 via EFS**
on _____

Signature /Michele A. Zarinelli/

Typed or printed name Michele A. Zarinelli

In re Application of

Kuen-Yih Hwang

Application Number
10/687,728

Filed **10/16/03**

For Location Caller Identification Information Method and Apparatus

Art Unit
2617

Examiner
Brandon J. Miller

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ **500.00**

- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____
- ☐ A check in the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☒ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.
- ☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.
- ☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

/Michael B. Johannesen/

Signature

Michael B. Johannesen

Typed or printed name

- ☒ attorney or agent of record. **35,557**
Registration number _____

(630) 300-2727

Telephone number

- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

July 18, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit: 2617
)	
HWANG, Kwen-Yih, <i>et al.</i>)	Examiner: MILLER, Brandon
)	
Serial No.: 10/687,728)	<u>REMARKS FOR PRE-APPEAL</u>
)	<u>BRIEF REQUEST FOR REVIEW</u>
Filed: 10/16/2003)	
)	
Atty. Docket No.: P3108)	
)	
Title: "Location Caller)	
Identification Information Method)	
and Apparatus")	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants submit these remarks in support of their Pre-Appeal Brief Request for Review. Reconsideration and withdrawal of the rejections of the claims are respectfully requested as set forth herein.

REMARKS

The pending claims remaining after entry of Applicants' Amendment After Final are **Claims 1 – 7 and 50 – 61**. **Claim 1 – 7** stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Publication Number 2002/0102989 A1 to Calvert *et al.* (herein "*Calvert*") in view of U.S. Patent Publication Number 2003/0035544 to Herle *et al.* (herein "*Herle*"); **Claims 50, 52, 54 – 55, 57 and 59 – 61** stand rejected under 35 U.S.C. §103(a) as being obvious over *Calvert* in view of U.S. Patent Number 6,049,718 to Stewart (herein "*Stewart*"); **Claims 51 and 53** stands rejected under 35 U.S.C. §103(a) as being obvious over

Calvert in view of *Herle* and further in view of *Stewart*; and **Claims 56 and 58** stand rejected under 35 U.S.C. §103(a) as being obvious over *Calvert* in view of *Stewart* and further in view of U.S. Patent Number 6,665,611 to Oran *et al.* (herein “*Oran*”).

Applicants respectfully assert that the Examiner erred in his rejection of claims 1 – 7. Applicants respectfully assert that *Calvert* and *Herle* do not teach or suggest the functionality of all of the elements of applicants’ invention. Further, Applicants respectfully assert that there is no teaching or suggestion in either *Calvert* or *Herle* that these two references can be combined. Specifically, neither *Calvert* nor *Herle*, taken alone or together, teach or suggest the element of:

a location service center node connected to said communication network and

- (1.) configured to receive a request for location related information from a requesting one of said first and second communication devices regarding either one of said first and second communication devices,
- (2.) configured to validate that said request is permissible and
- (3.) configured to deliver said location related information to said requesting one of said first and second communication devices. (Claim 1, lines 7 – 12, paragraphing and element numbering added for clarity).

In contrast, *Calvert*, which the Examiner relies on for all but element (2.), discloses a method and apparatus for determining a precise location of a wireless communications device by asking the user of the communications device where he or she is. The user’s manual input is then delivered back to the system infrastructure, which conveys the manually-generated location information to a target device. *See Calvert* paragraphs [0020] and [0021]. It is important to note that there are three communications devices discussed in *Calvert*: a “particular device,” a “requesting device” and a “target device.” The “particular device” is the device to be located. The “requesting device” is the device making the request for location. The “target device” is the device to which the location information regarding the “particular device” is delivered.

In *Calvert*, when a “requesting device” requests location information regarding a “particular device,” the “target device” may also be the “requesting device.” *Calvert*,

paragraph [0034]. *Calvert* also teaches that when the “requesting device” is also the “particular device,” the “target device” is another communications device. *Calvert*, paragraph [0034]. *Calvert* does not teach or suggest that the “particular device,” the “requesting device” and the “target device” may all be the same device.

Thus, *Calvert* does not teach elements (1.) above. *Calvert* is not configured to “receive a request for location related information from a requesting one of said first and second communication devices regarding either one of said first and second communication devices” because *Calvert* teaches a first device requesting information regarding a second device (a “requesting device” regarding a “target device”) or sending location information manually input from a first device to a second device unsolicited (a “particular device” to a “target device”). *Calvert* does not clearly teach that the request may be reciprocal.

However, *Calvert* clearly does not teach or suggest that a device may request location information regarding itself. This argument is further strengthened by *Calvert*’s teaching that, when the “requesting device” is also the “particular device,” the user may bypass interaction with the infrastructure and just manually enter and send location information to the “target device.” *Calvert*, paragraph [0036].

For the same reason, *Calvert* does not teach element (3.) above. The system of *Calvert* may be thought of as a “one-way street.” *Calvert* teaches delivering manually entered location information to a “target device,” which is never referred to in *Calvert* as being the “particular device.” It is contradictory to assert that manually-entered location information would be sent back to the requesting device when the requesting device is the particular device and the target device. *Calvert*’s system cannot answer the question “where am I?” Applicants’ invention, as claimed in claim 1, and specifically elements (1.) and (3.) above, can answer the question “where am I?”

As to element (2.), above, Applicants agree with the Examiner that validating the location request is not found in *Calvert*. Applicants respectfully assert, however, that filing in this gap with the teaching of *Herle* is an error. There is no teaching or suggestion in either *Calvert* or *Herle* that it would be desirable to combine the two references. *Calvert* specifically teaches determining locations of communications devices by asking the user of the device where he or she is. It is likely that *Calvert* is silent about validation because

Calvert specifically asks the user of the communications device where he or she is. Such request provides sufficient validation.

In contrast, *Herle* automatically tracks a mobile station and records the location on an Internet-based mobile station location server. The user of the mobile station is not necessarily aware of the tracking. Further, any client access device connected to the Internet can access the mobile station location server. Therefore, the request must be validated to prevent unauthorized location requests. Such validation is not required in *Calvert*. Thus, there is no motivation for combining *Calvert* with *Herle*. Therefore, Applicants' independent Claim 1 is patentable. Claims 2 – 7 depend from allowable claim 1 and are therefore likewise allowable.

For the forgoing reasons, Applicants' invention as claimed in claims 1 – 7 is not obvious over *Calvert* in view of *Herle*. Withdrawal of this rejection and allowance of these claims is respectfully requested.

Claims 50 – 61 stand rejected under 35 U.S.C. §103(a) as being obvious under *Calvert* in view of *Stewart* and, for some of the dependent Claims, *Calvert* in view of *Stewart* and *Herle* or *Oran*. Applicants respectfully assert that the Examiner erred in his rejection of these claims because not all of the elements of claim 50 can be found in the cited art.

Specifically, neither *Calvert* nor *Stewart* teach or suggest Applicants' claim element of "delivering a call set up signal to said second communication device, said call set up signal including the location of the first communication device." Claim 50, lines 8 and 9. The Examiner relies on *Stewart* for the proposition that "Stewart teaches delivering a call setup signal to the second communication device, the call set up signal including information from the first communication device (see col. 4, lines 8 – 15)." Office action, page 9, lines 14 – 16.

It is respectfully submitted that this is an incorrect interpretation of the cited passage in *Stewart*. In the cited paragraph, *Stewart* states:

The incoming call, in particular the incoming call data in the form of an incoming location request code and optionally a re-location request code, is then transmitted (210) to the called portable telephone 28.

The “data” in *Stewart*’s incoming call is a “location request code” and/or a “re-location request code.” The “data” sent in the call setup signal in *Stewart* is not is location information, it is a request for location information. *Stewart* specifically teaches that the “location request code” is a code that requests the called telephone to transmit its location (derived from an internal GPS receiver). *Stewart*, Col. 4, lines 24 – 44. Thus, in *Stewart*, location information is actually delivered about the called telephone to the calling telephone. Applicants’ claimed invention is delivering location information about the calling telephone to the called telephone. Thus, the Examiner erroneously equates requesting location information with location information itself. Therefore, this rejection cannot stand because there is no *prima facie* showing of obviousness.

Claims 51 – 61 depend from allowable claim 50 and are likewise allowable.

For the foregoing reasons, Applicants’ claims 1 – 7 and 50 – 61 are in form for allowance. Therefore, it is respectfully requested that claims 1 – 7 and 50 – 61 be allowed and this application passed to issuance.

Respectfully submitted,

/Michael B. Johannesen/
Michael B. Johannesen, Reg. No. 35,557
Intrado
1601 Dry Creek Drive
Longmont, Colorado 80503

Telephone: (630) 430-1502

Date: July 18, 2006